

Appl. No. 09/991,249
Atty Docket No. 1205-010/JRD
Amendment Dated March 9, 2005
Reply to Office Action of November 10, 2004

REMARKS

A non-final Office Action, dated April 28, 2004, rejects pending claims 1-24. Claim 1 has been amended herein. Reconsideration is respectfully requested in of the following remarks.

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-24 as somehow being rendered obvious by the references of record. The references of record are either missing essential elements, or they are missing a teaching or suggestion to combine them as currently claimed.

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" [MPEP § 2143.01]. Applicants traverse the examiner's rejections of these claims on at least the following grounds:

1. There is no teaching to attach a wireless tag in communication with a computer system to a supply container and use this information to automatically verify that a customer's prescription order has been properly filled from the correct supply container.

Applicants respectfully traverse the examiner's comment that U.S. Patent No. 6,564,121 to Wallace et al. ("Wallace") somehow teaches "positioning a supply container (20) of a drug near the prescription container, wherein the supply container bears a second tag with an assigned code (see col. 8, lines 32-58); and automatically comparing the identity of the prescribed drug with the identity of the drug in the supply container (see col. 8, lines 32-58.)" (April 28, 2004 Office Action, page 2, lines 15-17) Wallace et al. neither teaches nor suggests such a structure.

The sections of Wallace noted by the examiner teach loading up columns of an automated pharmacy dispensing cabinet (20) with individual vials filled with a specified dose of a medication. Presumably, but not specifically discussed in Wallace, at some point in the filling process, a pharmacy worker somewhere in the filling chain, filled each of the vials with the designated doses of medication. The medication in each vial originated from a common supply container containing bulk amounts of the medication. However, unlike the present invention as currently claimed, Wallace neither teaches

Appl. No. 09/991,249
Atty Docket No. 1205-010/JRD
Amendment Dated March 9, 2005
Reply to Office Action of November 10, 2004

nor suggests any systems to verify that the medication from this common bulk supply container was in fact placed into the properly labeled vials.

Turning to the claims, claim 1 specifically requires the steps of:

- 1) "positioning a supply container of a drug near the prescription container to disburse the drug from the supply container to the prescription container, said supply container bearing a second wireless tag assigned a second code for identifying the drug within the supply container, said second code capable being automatically detected by a computer system within the interrogation zone;" and,
- 2) "automatically comparing the identity of the prescribed drug with the identity of the drug in the supply container when the prescription container and supply container are in said interrogation zone at the same time.
(emphasis added)

Independent claim 19 includes similar limitations.

Since neither Wallace nor any other reference of record teach or suggest such steps, they cannot render claims 1 or 18 obvious. Moreover, since dependent claims 2-18 depend on allowable claim 1, and dependent claims 20-24 depend on allowable claim 19, they too should be in condition for allowance.

2. No references of record teach or suggest a computer system that flags a detected discrepancy between the identity of a drug in a supply container with the identity of the drug to be dispensed to a customer.

"It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP Sec. 2144.03(A). Applicants respectfully traverse the examiner's statements that automatically flagging a pharmacy supply container dispensing error with transducers would be "obvious to one of ordinary skill in the art at the time the invention was made." (April 28, 2004 Office Action, Page 3, lines 4-5). Pursuant to MPEP Sec. 2144.03(C), applicants respectfully request documentary evidence to support the examiner's position on this issue.

As previously noted, neither Wallace nor any other references of record teach or suggest using wireless identification tags, which have historically been used to track objects, as a tool for automatically verifying that the correct medication was dispensed


Appl. No. 09/991,249
Atty Docket No. 1205-010/JRD
Amendment Dated March 9, 2005
Reply to Office Action of November 10, 2004

from a supply container within a pharmacy. There is also no teaching or suggestion in any references of record that teaches using a computer system to alert a pharmacy worker of such a discrepancy (claim 1) or to use wireless tags with transducers (claim 2), such as lights (claim 3) or audio speakers (claim 4), to accomplish this alerting step. Accordingly, these claims are also patentable on these grounds.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

March 9, 2005

By 
John R. Dawson
Registration No. 39,504

Ipsolon llp
805 SW Broadway # 2740
Portland, Oregon 97205
Phone No. (503) 419-0702
Fax No. (503) 249-7068
E-Mail: john@ipsolon.com